

REMARKS

(Amendment B-Ser. No. 09/352,192)

By the foregoing amendment, the applicant has made minor grammatical changes to claims 3 and entry of theses changes is requested. The applicant attempted to make these changes before but they were not entered due to an obviously mistaken use of the numbers of these claims from the parent application. Applicant has also made minor corrections of misnomer in the specification and has provided the serial numbers for the various applications incorporated by reference as requested by the examiner. Entry of all these amendments is respectfully requested.

Reconsideration of the rejection of the claims 1-3 under the judicially created doctrine of obviousness-type double patenting. As previously noted, because of the prior restriction requirement, there is absolutely no proper basis for such a rejection. The Patent and Trademark Office cannot first claim that these claims are distinct for purposes of imposing a restriction requirement and thus force the applicant to limit his claims and cancel the nonelected claims and then later claim that these same claims are not distinct when a divisional application is filed on them. The rejection must be withdrawn for this reason alone, in addition to the other reasons previously asserted.

Although the applicant is surprised that the Examiner repeated an obviously unsupportable double patenting

rejection even after being informed of these facts and had an opportunity to examine the record in the Patent Office. For purpose of record on appeal, attached is the requested copy of the Office Action of March 4, 1997 in which claims 36, 37 and 38 were made subject to a restriction requirement. Can the examiner still deny these facts?

Claims 4-6 are the identical method counter-parts of the apparatus claims 1-3, and thus if claims 1-3 are barred from a double patenting rejection then claims 4-6, must also be barred. Withdrawal of the double patenting rejection for all claims and not only claims 1-3 is therefore requested.

Withdrawal of the finality of the rejection is requested. The reason given for the finality was that the applicant's amendment necessitated the new grounds of rejection, when, in fact, in the same action it is stated that " On page 1 of the Amendment: The changes to claims 36-38 were not entered because claims 36-38 does not exists in this instant application."

Although, claims 4-6 were added by amendment, as noted above, they are merely the identical method counter parts of claims 1-3. There is no new ground of rejection. The old grounds of rejection that were not overcome were double patenting and anticipation by Hill et al. (US 4,034,210); The so-called "new grounds" of rejection are double patenting over U.S. Patent No. 5,494,544 and anticipation under Section 102 by Hill et al. (US 4,034,210). Thus, in fact, the "old" and the "new" are one and the same. There was no basis to make the last action a final action because there are "new grounds" of rejection.

Reconsideration of the repeated rejection of the claims under 35USC102(B) as being anticipated by Hill et

al. (U.S. patent 4,034,210) is respectfully requested for the same reasons set forth in the remarks to the last amendment. A rejection under Section 102 requires that each and every one of the elements of the claim appear in the references. As previously explained in detail, there are three elements of the claim that are lacking from the reference:

"Thus, as illustrated above, the Hill et al. '210 patent completely lacks three features of claim 1, each of which is critical to the invention: (1) Hill et al. '210 lacks any means whatsoever for producing cards (only making match-mismatch determinations), as specified in the preamble); (2) Hill et al. lacks any means for determining whether a card has been "incorrectly prepared" (only making mismatch determinations), as specified in the second element of the claim; and (3) there are no means for preventing an "incorrectly prepared card" (i.e. the card that is being prepared by the card package production system) from being inserted into a carrier, as specified as the second element of this claim. Accordingly, there is no possibility that the Hill reference can anticipate any of the claims under 35UCS102(a). There is absolutely no support for the rejection of these claims on this basis, and withdrawal of the rejection on this basis is therefore respectfully requested. Withdrawal of the rejection is therefore respectfully requested."

The examiner has not denied that there are three elements that are entirely lacking from the reference, and thus the existence of these elements should be taken as admitted. Accordingly, in effect, it is admitted that there

is no basis for repeating the rejection that was obviously overcome by the applicant's remarks. If not, then even the briefest reading of the Hill et al. reference would demonstrate these distinguishing facts to anyone having interest in knowing the truth. It is not appropriate to simply ignore the applicant's remarks and the truth that they speak. Nothing is gained by merely repeating a rejection that has already been shown to be based on erroneous assertions of elements present in a reference or a denial of express limitations in the claims. The rejection should be withdrawn and the claims allowed, or the examiner should provide a basis for the rejection other than the erroneous assertion of which he has doubly been made aware.

Since repetitive errors cannot ever lead to a resolution, the applicant is not optimistic and rather than file a continuing prosecution application to resolve these issues which they would do if progress could be seen, they feel they must appeal. Accordingly, a notice of appeal is being filed contemporaneously with this response.

Nonetheless, reconsideration and allowance of all claims, claims 1-6, are therefore respectfully requested. In any event, entry of the above house-keeping amendments is requested.

If the examiner is still having difficulty understanding anything stated here or previously, the undersigned would be pleased to respond to a call for an interview to provide further explanation

Please note that enclosed change of address form being

filed herewith and the new telephone numbers noted below.

Respectfully submitted,

James W. Potthast,
Reg. No. 26,792

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CERTIFICATE OF MAILING BY EXPRESS MAIL

I certify that this Amendment B is being deposited on July 21, 2003, with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to: Mail Stop: Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail No. EU905419054US


Sara M. Potthast

RECEIVED

JUL 24 2003

OFFICE OF PETITIONS

3200 N LAKE SHORE DRIVE
CHICAGO IL 60657



DATE MAILED:

03/04/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

due 4/3/97
SM

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 36-44 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
_____ have been cancelled.
_____ are allowed.
_____ are rejected.
_____ are objected to.
6. ☒ Claims 36-44 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____ Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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JUL 24 2003
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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 36-38, and 42-44, drawn to methods and devices for verifying the correctness of produced cards and mounting the cards to forms, classified in class 235, subclass 437.

II. Claims 39-41, drawn to a method of mounting cards to a plurality of different types of mailing forms, classified in class 235, subclass 375.

1. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the methods and devices of verifying the correctness and mounting the cards to forms do not have to be utilized in the group II method of mounting to different types of forms. The subcombination has

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separate utility such as a system which does not verify the correctness of the prepared cards.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to James Potthast on February 26, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Filipek whose telephone number is (703) 305-3505.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Papers related to this application may be submitted to Group 2500 via facsimile transmission. The faxing of such papers must conform with the notice published in the *Official Gazette*, 1096 OG 30 (November 15, 1989). In order to expedite delivery to the Examiner, draft copies or informal proposed amendments should be clearly marked as "DRAFT COPY" or "HAND DELIVER TO EXAMINER FILIPEK". The Art Unit fax number is (703) 308-7723.

Jeffrey R. Filipek
March 2, 1997

DONALD T. HAJEC
SUPERVISORY PATENT EXAMINER
GROUP 2500